

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 12
BAC

9/12/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Frank A. Bonomo

Serial No. 75/162,539

Request for Reconsideration

Myron Amer of Myron Amer, P.C. for Frank A. Bonomo

Cynthia Sloan, Trademark Examining Attorney, Law Office 111
(Craig Taylor, Managing Attorney)

Before Hohein, Chapman and McLeod, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On August 7, 2000 the Board affirmed the Examining
Attorney's refusal to register applicant's mark under
Section 2(d) of the Trademark Act. On August 17, 2000
applicant filed a request for reconsideration.

Applicant contends that the while Board decided the
case on the record, the record was circumscribed by a
double standard. Specifically, applicant contends that its
references to "common experience" were rejected by the

Board (Decision, footnote 4), but that the Board accepted as facts the Examining Attorney's statements that: (i) applicant's argument that its mark puts the onus on the would-be smoker to resist smoking addiction, and registrant's mark puts the onus on the registrant to effect treatment of heart disease is irrelevant, and (ii) because the distinction between the marks is not made on a side-by-side comparison, prospective purchasers would not pause or analyze where the onus is placed with regard to the involved services.¹

The Board did not accept unsupported factual statements of the Examining Attorney, nor did we, in effect, take judicial notice of any statement made by the Examining Attorney. Rather, the Board discussed our consideration of the du Pont² factor of the similarity or dissimilarity of the marks by first stating established law (e.g., marks must be considered in their entireties, not by their component parts, and that the proper test in determining likelihood of confusion is not a side-by-side

¹ In its one and one-half page request for reconsideration, applicant did not specify exactly which portion(s) of the August 7, 2000 decision are in error, quoting instead only from the Examining Attorney's brief. Upon a review of the record, including our previous decision in this case, we presume that applicant is referring to the Board's discussion of the involved marks. (Decision, pp. 5-7.)

² In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

comparison of the marks, but rather is a determination based on the similarity of the overall commercial impressions of the involved marks³). We then noted the differences between the involved marks, but found that purchasers would be unlikely to remember the specific, minor differences. Finally, we discussed the connotation of both marks relating to fighting to save the reader's life, and that we simply did not agree with applicant's analysis that consumers would be aware of and pay close attention to the differences in the marks and analyze the marks in terms of the technical grammatical analysis

³ We note that in our August 7, 2000 decision, in referring to the legal test that marks are considered in their entirety, we paraphrased McCarthy as follows: "This principle is based on the common sense observation that the overall impression is created by the ordinary purchaser's cursory reaction in the marketplace, not from a meticulous comparison of possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2000)." The precise quote from §23:41 on the anti-dissection rule reads, in part, as follows:

"The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed legal briefs."

This use by the Board of the words "common sense" (Decision, p. 5) was in the context of explaining the legal test, not setting forth a factual finding in the case.

proposed by applicant. That is, we set forth the relevant established law, and applied that law to the facts of the case before us.

Inasmuch as we find no error in our August 7, 2000 decision, applicant's request for reconsideration is denied.

G. D. Hohein

B. A. Chapman

L. K. McLeod
Administrative Trademark Judges,
Trademark Trial and Appeal Board